

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the reasons that follow.

This reply neither adds, changes, nor deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claims 1-33 as well as claims 34, 37, 40, 43, 46, and 48 remain pending in this application (Claims 35-36, 38-39, 41-42, 44-45, and 47 having been cancelled without prejudice or disclaimer in a preliminary amendment of August 2006).

Applicant is grateful for the examiner's determination that claims 1-33 are allowed. Applicant believes that all the other claims should be allowed also. Favorable reconsideration of the application is respectfully requested.

RESPONSE TO REJECTION

Claims 34 – 48 stand rejected under 35 U.S.C. 135(b)(1) for allegedly not being made within one year of the issue date of U.S. Patent No. 6,702,483 (Tsuboi). Applicant respectfully traverses the rejection.

Regarding the claims cancelled in the August 2006 preliminary amendment, those claims were outside the examiner's jurisdiction by the time of the December Office Action, so the rejection as to them is without effect and ought to be withdrawn.

Regarding independent claims 34, 37, 40, 43, and 46 as well as dependent claim 48, applicant respectfully submits that the Office has not established a prima facie case. Applicant further respectfully submits that the Office has not fulfilled its statutory and regulatory obligations under 35 U.S.C. 132(a) and 37 C.F.R. 1.104(a)(2) to provide applicant information "useful in judging the propriety of continuing the prosecution." See MPEP §§ 707; 707.07(f) (examiner should "answer the substance" of applicant's argument); 707.07(g)

(“where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.”).

Applicant respectfully submits that the Office should conduct a two-step analysis. First, determine whether applicant’s claims are directed to the same or substantially the same subject matter as a patent’s claims. 35 U.S.C. § 135(b)(1). Second, determine whether applicant’s post-critical date claims are supported by its pre-critical date claims. Regents of the University of California v. University of Iowa Research Foundation, 455 F.3d 1371, 79 USPQ2d 1687, 1689 (Fed. Cir. 2006) (if pre-critical date claims support post-critical date claims, § 135(b)(1) “will not act as a bar.”). Applicant respectfully submits that the Office has not accomplished either step.

For example, the Office has not expressly stated which, if any, of applicant’s rejected claims are claiming the same or substantially the same subject matter as which claims of the Tsuboi patent. If in the Office’s view such a condition exists, applicant requests the Office to expressly so state and to specify the respective claims. On the other hand, if applicant’s claims are not for the subject matter of the Tsuboi patent claims, then section 135(b) has “no applicability.” In re McGrew, 120 F.3d 1236, 1239, 43 USPQ2d 1632, 1635 (Fed. Cir. 1997).

As a further example, the Office has not identified any material limitations present in the rejected claims that are absent from claims 1-33.¹ If in the Office’s view there are any material limitations in any of the rejected claims lacking support in the allowed claims, applicant requests the Office to identify each such limitation. Otherwise, the rejection should be withdrawn.

Page 2 of the Office Action states that applicant had suggested an interference “in a communication filed July 28, 2006.” On the contrary, applicant’s reply of July 2006 contained no suggestion for an interference. Indeed, it contained not even the word

¹ As an example, every limitation of claim 34 is present essentially verbatim in allowed claims 20 and 23. This prima facie evidences the impropriety of the present Office Action in which the PTO has used section 135(b) to reject claims having clear support in earlier, pre-critical date claims.

“interference.” Since examination is not complete, applicant understands that an actual Rule 202 suggestion for an interference would be premature at this time.

Applicant respectfully reserves the right to wait until after examination is complete before deciding whether to formally request an interference. See 37 C.F.R. § 41.102(a); MPEP §§ 2301 (“It is also important to complete examination before the possible interference is referred to the Board.”); 2303 (“An interference should rarely be suggested until examination is completed on all other issues.”); Form paragraph 23.01 (where examination not completed, consideration of a potential interference is “premature”).

IDS

Accompanying this reply is an information disclosure statement listing the Plateau reference and what purports to be a translation/paraphrase/characterization of it available from the internet, relating inter alia to non-miscible liquids having the same density.

In summary, applicant respectfully submits that the Office should properly apply the correct legal test for § 135(b)(1): determine whether post-critical date claims are directed to the “same or substantially the same” subject matter as claims of the Tsuboi patent, and if so, determine whether those post-critical date claims are supported by pre-critical date claims.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By 

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